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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,633	10/23/2003	Joseph S. Beda	13768.783.20.1	8889
47973 7590 05/03/2007 WORKMAN NYDEGGER/MICROSOFT 1000 EAGLE GATE TOWER 60 EAST SOUTH TEMPLE SALT LAKE CITY, UT 84111			EXAMINER WOODS, ERIC V	
			ART UNIT 2628	PAPER NUMBER
			MAIL DATE 05/03/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/693,633

Applicant(s)

BEDA ET AL.

Examiner

Eric Woods

Art Unit

2628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 1-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-35 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/2/2007 has been entered.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 3/07/2007 was filed after the mailing date of the RCE on 1/2/2007. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

It is respectfully noted that applicant's submission on 3/7/2007 seems to consist of a re-submittal of much of the art previously cited in this case and its parent case (USSN 10/401,717). For purposes of expediting prosecution, applicant is kindly asked to please avoid further resubmission of previously cited / redundant art, since it places a significant burden on examiner to determine what, if any, of the submitted material has not been previously considered.

Response to Arguments

Applicant's arguments with respect to claims 1-35 have been considered but are moot in view of applicant's requirement to amend the claims to conform to the originally elected group and withdrawal of aforementioned claims.

It is respectfully noted that based upon brief observation of the amendment, the version of claim 1 filed with this paper appears to have the following deficiencies:

1. The claim 1 appears to impermissibly mix statutory categories of invention. The claim is directed to a method, but the majority of the claim is directed to providing various items (application programming interface, parser / translator, visual API, etc) having specific characteristics. Therefore, it is unclear whether the claim is directed to a method or a system. The claim 1 is directed to both a system and process of using, which is clearly indefinite.

Such an observation and/or suggestions are only added to provide assistance to the applicant in drafting further versions of these claims, where such suggestions should not be considered official positions taken in any context.

Election/Restrictions

Newly submitted claims 1-35 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: See Office Paper dated 3.27.2007. It no longer conforms to group I that was elected. Such a system would, not incidentally, be directed to class 717, subclasses 109, 113, 136, etc (e.g. previously non-elected Group II).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1-35 stand withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Applicant is required to amend the claim to conform to the original elected group, with respect to claims filed 4/27/2006, wherein the applicant elected group I, in Office paper dated 3/27/2006, wherein the current amendment mixes Group I and Group II. Such election was assumed by the Office to be without traverse as stated in Office paper dated 8/8/2006 (MPEP 818.03(c)) because it did not state with or without traverse, and applicant's reply on 10/23/2006 did not contest such, nor did it specifically point out any errors made in such restriction requirement (MPEP 818.03(a)). That requirement was not contested prior to close of prosecution (11/17/2006) under the previous RCE (37 CFR 1.144), when such requirement was made final. As such, it is not believed to be petitionable via 37 CFR 1.144 and/or 37 CFR 1.181 for reasons of prosecution history estoppel and for reasons that no petition was filed contesting such requirement within the time frame set by 37 CFR 1.181(f), and after no request for reconsideration was made and the requirement was repeated (37 CFR 1.181(c)), and no request for deferment was made (37 CFR 1.144) after the close of prosecution, thusly justifying a holding of estoppel as above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Woods whose telephone number is 571-272-7775. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ulka Chauhan can be reached on 571-272-7782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Eric Woods

April 25, 2007


ULKA J. CHAUHAN
PRIMARY EXAMINER